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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,398	03/30/2004	Seth Goldberg	GBAND-0003	1750
23599	7590	03/08/2006	EXAMINER	
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			HENDERSON, MARK T	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/812,398

Applicant(s)

GOLDBERG ET AL.

Examiner

Mark T. Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-12 is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED OFFICE ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing or responses to Office Actions directly into the Group at (571) 273-8300. This practice may be used for filing papers, which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1, 2, and 5 have been amended for further examination. Claims 7-12 have been added.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. Claim 1 recites the limitation "the display surface" in line 9. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Goins (2,716,390) in view of Alden (5,577,459).

Goins discloses a bookmark comprising an elastic band (1 – flexible loop) having a selected width and thickness and being expandable from a relaxed condition to a stretched condition when placed over a page of a book and over an outside cover of the book (as seen in figure 1); a slider (2) mounted on the elastic band having an outer display surface facing away from the elastic band and an inner surface facing toward the elastic band (as seen in figures 1 and 2); and an image support area (the examiner considers the image support area to be located any

where in the outer surface of the pointer/slider), and having a width greater than the width of the elastic band (as seen in figure 1).

However, Goins does not disclose: the image support area having an image thereon; first and second wings extending from the display surface having flanges which are folded to form first and second tubes and first and second gaps in the first and second tubes sufficiently large to receive the edge of the elastic band.

Alden discloses a bookmark having a slider (1) having an image support area on the display surface with an image thereon ("Paragraph Last Read"). Alden further discloses a bookmark comprising a body (2) and a sliding collar (1) having an aperture (3). The collar includes a set of wings extending from the display surface of the collar having flanges which are folded to form a tube and a gap in the tube sufficiently large to receive the body of the bookmark (as seen in figure 2).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the slider with first and second wings forming first and second tubes, as taught by Alden, to provide a secure, frictional engagement between the slider and the bookmark body.

In regards to **Claim 1**, it would have been obvious to include as many wings with tubes and gaps on the slider as desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, it would have been obvious to include any plurality of parts of the wings, since applicant has not disclosed the

criticality of having a particular number of parts, an invention would function equally as well with any desired number.

4. Claim 2 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Goins in view of Alden and further in view of Porto (5,408,950).

Goins, as modified by Alden, discloses the claimed invention except for the slider having a sticker attached thereto, the sticker having an image on the front surface and adhesive on the back surface.

Porto discloses that it is known to provide a bookmark with a sticker by disclosing a bookmark having a display device comprising a head portion (12) including a flat display head (16) having a pressure-sensitive adhesive coating (18) applied to some or all of the back surface (20) of the display head (16).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the slider with a sticker, as taught by Porto, to display messages, greeting, business logos and cards, photographs, etc., thereon.” (see column 1, lines 32-44).

#### ***Allowable Subject Matter***

5. Claims 3-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 7-12 are allowed.

***Response to Arguments***

Applicant's arguments filed on July 20, 2005 have been fully considered but they are not persuasive.

In response to applicant's arguments that the Goins reference does not disclose first and second wings having foldable flanges forming first and second tubes, the examiner submits Alden is used to disclose an image support area having a wing with flanges folding to form a tube. It would have been obvious to include as many wings with tubes and gaps on the slider as desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, it would have been obvious to include any plurality of parts of the wings, since applicant has not disclosed the criticality of having a particular number of parts, an invention would function equally as well with any desired number.

***Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mitcham, Antoine, Olson, McKinney, and Forance disclose similar bookmarks.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571) 272-4477, and informal fax number is (571) 273-4477. The examiner can be reached on Monday-Friday from 9:00AM to 3:45PM. If attempts to reach the examiner by telephone are unsuccessful, the Examiner Supervisor, Boyer Ashley, can be reached at (571) 272-4502. The formal fax number for TC 3700 is (571) 273-8300.



MTH

March 3, 2006



BOYER D. ASHLEY  
SUPERVISORY PATENT EXAMINER